

AMENDMENT UNDER 37 C.F.R. § 1.116

Appl. No.: 09/851,983

ATTORNEY DOCKET NO. Q70839

REMARKS

The present invention relates to a coating composition suitable for use as an automotive top coating. The instantly-claimed coating composition demonstrates an excellent appearance irrespective of humidity conditions present during the application of the coating. The composition also exhibits good weather resistance and stain resistance.

Claims 1, 8 and 9 have been rejected under 35 U.S.C. §§ 102 and 103. Claims 2-9 have been objected to. The Examiner has indicated that claims 2-7 recite allowable subject matter.

Applicants have amended claims 1 and 2 and canceled claims 8 and 9.

Claim 1 has been amended to recite to subject matter of claim 9. Applicants have amended claim 1 in a manner that overcomes the objection to claim 9. The alkoxy groups have been centered with respect to the silicon atom, and the variable “R₃” has been replaced with the substituent “CH₃.” Applicants note that the previously entered “R₃” was a typographical error, which should have been “CH₃.” Applicants note that support for this amendment can be found, e.g., on page 7, at lines 18-19.

Claim 2 has also been amended so that the alkoxy groups are centered with the silicon atom.

Upon entry of the above amendment, claims 1-7 will be all the claims pending in the application.

Claim Objections

Claims 2, 8 and 9 have been objected to for various informalities. Applicants have canceled claims 8 and 9 and amended claim 2 so as to overcome the objections. In light of the

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amendment to claim 2, Applicants respectfully request that the objection be reconsidered and withdrawn.

Claim Rejections

Claims 1, 8 and 9 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. § 103(a), as allegedly being obvious over the abstract of JP 60-199074 A (“JP ‘074.”)

It is asserted that the graft polymerization of an organosilicate compound and a hydrolyzable silyl group-containing resin would ultimately yield the same composite resin as is produced when an alkoxy silyl group-functionalized polymer is reacted with silica particles. With respect to claim 9, it is asserted that the recited tetraalkoxysilanes are expected to react in a manner similar to that of the alkoxy silyl group-functionalized polymer of claim 1.

Applicants’ Response

As stated above, Applicants have amended claim 1 to recite the subject matter of claim 9. Furthermore, claims 8 and 9 have been canceled.

Applicants respectfully assert that the instantly claimed composition is neither taught nor suggested by JP ‘074. Applicants also present herewith evidence that there are unobvious differences between the present invention and the prior art product.

Applicants note that the recited organosilicate compound (II) is different from the silica used in the composition of JP ‘074. Applicants further note that the silicate-grafted resin (I) obtained by the reaction of the hydrolyzable silyl-containing resin (III) and the organosilicate compound (II) is patentably distinguishable product from that of JP ‘074.

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In a graft polymerization reaction, organosilicate compounds (II) react with one another in some degree, but not to the extent that the organosilicate compounds (II) would be changed to the same structure of silica since there is a hydrolyzable silyl-containing resin (III) in the reaction mixture. Therefore, the structure of the present invention and JP '074 are patentably distinct.

Applicants additionally note that the graft resin of the present invention has -OR substituents from the hydrolysable silyl-containing resin (III) and the organosilicate compound (II). The resin of JP '074 teaches -OH groups, but not -OR groups. In the present invention, the -OR group is needed in order to obtain the desired angle of contact with water. The composition of JP '074 does not have this feature.

In order to demonstrate that the presently-claimed composition is different from the composition of JP '074, Applicants submit herewith a Declaration Under 37 C.F.R. § 1.132 that contains a comparison of the claimed composition and the composition of the prior art.

In the Declaration, Example 1 is a representative embodiment of the present invention (a silicate-grafted resin (I)), and Examples 2 and 3 are an embodiments of the prior art (a reacted resin with colloidal silica particle and a reacted product of alkoxysilane compound with silica particles, respectively).

As illustrated by Table 1 on page 5 of the Declaration, the prior art embodiments yielded turbid varnishes at 70% humidity, whereas not only was Example 1 according to the present invention superior in clarity, but also, the instantly-claimed invention exhibited unexpectedly superior water and stain resistance over one- and six-month periods.

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Accordingly, Applicants respectfully request that the rejection of claim 1 be reconsidered and withdrawn.

In view of the above, reconsideration and allowance of remaining claims 1-7 are now believed to be in order, and such actions are hereby solicited.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at their local Washington, D.C. telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Patrick F. Gallagher
Registration No. 54,109

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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